

Image 1635

Patent
Attorney Docket No. 021565-075

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Meulewaeter

Application No.: 09/551,494

Filing Date: April 18, 2000

Title: Methods and Means for Delivering Inhibitory RNA to Plants and Applications Thereof

Group Art Unit: 1635

Examiner: Janet Epps

Confirmation No.: 2755

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

☐ A Petition for Extension of Time is also enclosed.

☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.

☐ Also enclosed is/are _____

☐ Small entity status is hereby claimed.

☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the
☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).

☐ Applicant(s) requests that any previously unentered after final amendments not be entered.
Continued examination is requested based on the enclosed documents identified above.

☐ Applicant(s) previously submitted _____

on _____,
for which continued examination is requested.

☐ Applicant(s) requests suspension of action by the Office until at least _____,
which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R.
§ 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.

☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims		MINUS =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims		MINUS =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

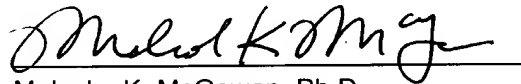
Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: Feb. 13, 2004

By



Malcolm K. McGowan, Ph.D.
Registration No. 39,300



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
Meulewaeter)	Group Art Unit: 1635
Application No.: 09/551,494)	Examiner: Janet Epps
Filed: April 18, 2000)	Confirmation No.: 2755
For: Methods and Means for Delivering)	
Inhibitory RNA to Plants and)	
Applications Thereof)	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Official Action mailed January 13, 2004, requiring restriction under 35 U.S.C. §121, Applicants hereby elect, albeit with traverse, claims 54, 55, 58, and 59.

1. At page 2 of the Official Action, the Examiner notes that new claims 53-60 appear to "recite sequence disclosures that were not previously searched with the claimed invention."

2. Although the Examiner has not divided the claims into formal groups, in paragraph 2 of the Official Action the claims are informally divided as follows:

A. Claims 53 and 57, reciting "a viral RNA vector comprising the nucleotide sequence of SEQ ID NO: 2 from nucleotide 5443 to 5518;"

B. Claims 54 and 58, reciting "a viral RNA vector comprising the nucleotide sequence of SEQ ID NO: 5 from nucleotide 5430 to position 5505;"

C. Claims 55 and 59, reciting “a viral RNA vector comprising the nucleotide sequence of SEQ ID NO: 12;” and

D. Claims 56 and 60, reciting “a viral RNA vector comprising the nucleotide sequence of SEQ ID NO: 4 from nucleotide position 1 to position 197.”

3. The Examiner asserts that a search of more than one of the recited RNA sequences “would present an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed nucleotides sequences.” However, Applicants note that new claims 53 to 60 merely represent specific embodiments within the scope of generic claim 32:

The specific RNA sequences recited by the claims of groups A to C all represent an origin of assembly (OAS) of tobacco mosaic virus (as supported in the specification at least on page 16, lines 5-11):

A. claims 53 and 57: SEQ ID No:2 from 5443 to 5518 is the OAS from TMV-U1 (*see also* Example 1, page 29, lines 8-10);

B. claims 54 and 58: SEQ ID NO:5 from 5430 to 5505 is the OAS from TMV-U2 (*see also* Example 1, page 29, lines 10-11, and Example 4, page 33, lines 17-19);

C. claims 55 and 59: SEQ ID NO:12 is also the OAS from TMV-U2 (*see also* Example 1, page 29, lines 11-12);

D. The RNA sequence recited by the claims of group D (SEQ ID NO:4 from 1 to 197) represents the “STMV leader” (used in the constructs of Examples 1 and 4) and still contains a part of the coat protein from STMV. (The coat protein is encoded by nucleotides 162 to 641 of SEQ ID NO:4, so

nucleotides 197 to 641 are that part of the CP encoding gene of STMV
that has been deleted in these constructs).

As Claims 54, 55, 58, and 58 all recite the same sequence, *i.e.*, the OAS from TMV-
U2, Applicants respectfully submit that these claims at least can be examined
without undue burden.

Please also note that original claims 38 and 49 already referred to a "viral
RNA vector derived from STMV and comprising an origin of assembly of TMV".
Consequently, we indeed believe that the election requirement is improper.
However, sine we must choose between these groups of claims, we suggest electing
groups 2 and 3 to be examined (as the claims in these groups refer to the same
sequence, From the foregoing, further and favorable reconsideration of all of the
claims of record on the merits is respectfully requested.

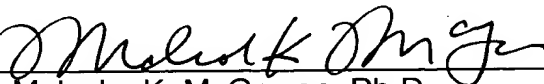
In the event that there are any questions relating to this application, the
Examiner is respectfully requested to telephone the undersigned so that prosecution
of this application may be expedited.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: February 13, 2004

By:



Malcolm K. McGowan, Ph.D.

Registration No. 39,300

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620